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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ronald Carr ✓

Group Art Unit: 3626

Serial No.: 08/952,001 ✓

Examiner: Alison Pickard

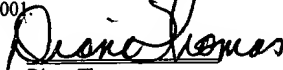
Filed: November 7, 1997

Docket No.: P 97 194.024

Title: JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET

CERTIFICATE OF MAILING

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Diane Thomas

Birdwell & Janke, LLP  
900 SW Fifth Avenue, Suite 1925  
Portland, OR 97204

May 16, 2001

RESPONSE AND REQUEST FOR RECONSIDERATION **RECEIVED**

MAY 23 2001

**GROUP 3600**

Assistant Commissioner for Patents  
Washington, DC 20231

Greetings:

This is in response to the Office action mailed April 9, 2001 in the above-identified patent application. Applicant respectfully requests reconsideration in light of the comments below.

Applicant and the Examiner have apparently reached an impasse. There are 3 points of contention:

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1) Whether as a matter of law, a reference can anticipate a claim if “there is nothing in the disclosure to indicate that the [structure disclosed] is not [the structure claimed].”

2) Whether the Examiner has properly grounded the obviousness rejections based on Mastin and Smith.

3) Whether the Examiner can properly assert that the claimed square periphery has no mechanical function.

Applicant respectfully requests reconsideration of the rejections in light of the following comments regarding the aforementioned points of contention:

#### First Point

The Examiner has made a legal assertion that is flatly contradicted by MPEP 2112 which states: “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”

Inherency means that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Id.* While the disclosure of Merwarth permits that what is claimed may be present (because what is claimed *could* be present and the reference does not state that it is not present), the MPEP is crystal clear that this is not sufficient to establish the inherency of that result or characteristic. The rejection is therefore improper.

#### Second Point

Applicant does not disagree that the test for obviousness includes whether the combined teachings of the references would have suggested the invention to those of ordinary skill in the art. However, this observation misses the point of Applicant’s argument.

To recapitulate, the Examiner has based the rejection on an asserted motivation (MPEP 2144) for combining the references: “to provide a gasket which can be properly aligned between a variety of different sized flanges [and] which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.” Applicant has not challenged whether the proposed motivation existed in the knowledge available to one of ordinary skill. Rather, Applicant argued that the proposed motivation is insufficient to result in the claimed combination. In simply dismissing Applicant’s argument, the Examiner is not being responsive.

Just because Mastin discloses sealing material and Smith discloses a locator, it does not follow that one should be combined with the other and both should be formed of the same sealing material as claimed. Smith discloses a snap-in locator ring formed of thin plastic, and Mastin discloses a packing formed of rubber. Even if the Examiner’s proposed motivation is accepted, it does not motivate the person or ordinary skill to do more than adapt the rubber packing of Mastin to receive a snap-in plastic locator ring, and therefore does not go far enough to motivate the invention claimed, which further requires forming both of the same sealing material. The Examiner has not offered any rebuttal to this point. That being the case, maintaining the rejections on this ground is improper.

Even ignoring the problem of how to combine Mastin and Smith, Smith does not even teach or suggest using the same material for forming the snap-in locator 41 as is used to form the rest of its flange seal. An inner ring 22 is formed of “thin metal or plastic.” An outer annular ring 31 is formed of a “similar material.” The locator 41 is formed of “thin plastic material such as polyethylene.” Granted, the reference leaves open the possibility that the locator 41, the rings 22 and 31 and the locator 41 could all be formed of the same “thin plastic material such as polyethylene,” there is no teaching or suggestion to make this specific combination.

### Third Point

Though the Examiner has still not affirmatively identified the authority for the rejection, she has not disagreed with Applicant's estimation that the rejection is based on MPEP 2144.01, and therefore that the rejection is based on an assertion that the square outer periphery is "mere ornamentation" and has "no mechanical function."

The Examiner makes two arguments to support this contention: (1) The claim language does not recite a mechanical function; and (2) it is possible to build a gasket having a square outer periphery wherein the corners are not useful for centering the gasket. The Examiner had previously made a third argument (3) that the square periphery is "mere ornamentation" because no function for the configuration was described in the specification. The Examiner has not supported any of these arguments with citations to the law.

MPEP 2144.01 does not define "mere ornamentation" and "no mechanical function," however, the difference between ornamentation and function is defined in the body of law dealing with design patents.

For example, in *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964), the Court of Customs and Patent Appeals affirmed a rejection for a design patent application for a gasket. The court found the gasket's features to be functional, and also cited a "hex-nut" as another example of a functional article. It is respectfully submitted that the Examiner's arguments are contradicted by *In re Carletti*.

First, the Examiner's arguments (1) and (3) assert that a feature cannot have a function if that function is not recited or claimed in a patent application. Yet *In re Carletti* affirmed a rejection for functionality of a gasket in a design patent application wherein no function was described or claimed.

If the Examiner's arguments (1) and (3) were correct, the court could not have concluded that the *Carletti* gasket was functional. Accordingly, arguments (1) and (3) cannot be correct.

Moreover, the court also presumed that a "hex-nut" is functional without any reference to any patent on the hex-nut explaining or claiming its function. If the Examiner's arguments (1) and (3) were correct, the court could not have concluded that a hex-nut is functional; hence, these arguments cannot be correct.

The Examiner's argument (2) is that a structure has no mechanical function where it is possible to use the structure so that its features are not accessible. But clearly, if that were correct, the CCPA could not have cited the hex-nut as an example of a functional article, because hex-nuts can be covered up or hidden so that they cannot be accessed and used in the intended manner just as much as can the corners of Applicant's gasket. Accordingly, the Examiner's argument (2) cannot be correct.

More particularly, the Examiner has suggested that the claimed element of the gasket of the present application may be rendered ineffectual (and therefore to have no mechanical function) where the gasket is installed in a pipe joint having flanges that are too large. But the argument applies with equal force to the gasket in *Carletti*. That case decided the question of functionality of a gasket. No less than the corners of Applicant's square gasket, the concentric annular ribs of the gasket of *Carletti* could also be rendered ineffective for their purpose of "better sealing" if the gasket was not used in suitably sized pipe flanges. Nevertheless, both the Board of Patent Appeals and the CCPA found with certainty that this feature of the *Carletti* gasket was functional. Accordingly, the Examiner's argument (2) cannot be correct.

In sum, all of the Examiner's arguments are flatly contradicted by the standing case law regarding functionality vs. ornamentation. Accordingly, the rejection on grounds of MPEP 2144.01 is clearly improper.

For all of the foregoing reasons, Applicant respectfully submits that claims 55 - 92 should be allowed and the case passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Garth Janke", with a long horizontal flourish extending to the right.

Garth Janke  
Attorney for Applicant  
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(503) 228-1841

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MAY 21 2001

TRANSMITTAL LETTER  
(General - Patent Pending)

GAM-3626  
Docket No.  
P 97 194.024

In Re Application Of: Ronald L. Carr

Serial No.  
08/952,001

Filing Date  
November 7, 1997

Examiner  
A. Pickard

Group Art Unit  
3626

Title: JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET

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MAY 23 2001

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**Response and Request for Reconsideration**

in the above identified application.

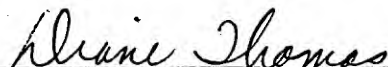
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Dated: May 16, 2001

Garth Janke, Reg. No. 40,662  
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Docket No.

P 97 194.024

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Examiner

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